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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,687	12/20/2000	David Stephen Gress	95-455	3289

23164 7590 09/26/2005

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EXAMINER

ZEWDU, MELESS NMN

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/739,687	Applicant(s) GRESS ET AL.	
	Examiner Meless N. Zewdu	Art Unit 2683	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 13,37,55 and 71.
Claim(s) rejected: 1-12,14-36,38-54,56-70 and 72-76.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 3. NOTE: See detailed explanation in the attached Office Action..

DETAILED ACTION

Response to Amendment (After Final)

1. This action is in response to the communication filed on 09/08/05.
2. This action is directed to a response for addressing applicant's arguments in response to the final action mailed on 7/11/05.

Arguments and corresponding responses are presented in the following fashion.

Argument I: with regard to the prior art of references, applicants argue by saying "there is **no legal basis whatsoever** for adding the teachings of Wong to the hypothetical combination of Patil and Ross", and "Wong is not analogous art because there is no teaching whatsoever that is related to the inventors' field of endeavor, namely supplying **messages** to a subscriber independent of message format; further, Wong is not reasonably pertinent to the particular problem with which inventors were involved, namely providing SMS messages to non-SMS device destinations."

Response I: examiner respectfully disagrees with the argument. First, the features, "supplying **messages** to a subscriber independent of message format and providing SMS messages to non-SMS device destinations" were not claimed, in such a manner. Hence, the argument is based on features that were not claimed. Nonetheless, the recited feature is taught by Patil, as can be seen in claims 1 and 6, for instance.

In response to applicant's argument that Wong is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Wong is concerned with a multi-media call signaling system and method which includes text message (E-mail) exchange. It is known that E-mail is exchanged using short message protocol. Furthermore, regarding pertinence, Wong is pointedly teaching that an E-mail content can be enriched by attachment so as to enable a short message carry as much information as possible (see col. 19, line 55-col. 20, line 3), the principle of which is based on encapsulation/enclosing (see col. 2, lines 14-22). In other words, the aspect of Wong directed to message encapsulation/enclosing is the feature relied upon by examiner. Hence, the argument, that Wong is not analogous art and/or does not teach or suggest enclosing any message whatsoever, is invalid and not persuasive.

Argument II: applicant argues that examiner's response in the Final Office Action, "call setup is not excluded by the claims", to applicant's assertion of Wong not being analogous because of it being related to multimedia call setup, is insufficient and hence, non-responsive to applicant's arguments.

Response II: examiner, besides the explanation provided in response I above, that Wong is a related/pertinent art, still maintains the assertion that the claims do not exclude call setup.

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Argument III: applicant further argues that examiner's response demonstrates a **blatant** disregard for the claims as a whole, and the explicit teachings of the references.

Response III: examiner respectfully disagrees this argument and provides objected claims as evidence that the claims were carefully considered as a whole.

Argument IV: applicant further argues and demands that "Wong must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention ---."

Response IV: examiner agrees with this argument; but, Wong, as a whole is concerned about text message exchange and this places the references within same field of endeavor. Examiner would not have used the encapsulation/enclosing technique had it not been with the context of this message exchange field of endeavor. Hence, this argument too is found not being persuasive.

Argument V: applicant further argues by saying that Wong does not enclose the original called user identifier specified in the original call setup.

Response V: examiner respectfully disagrees with the argument; in that the argument is based on a feature that was not claimed in such a manner. Nevertheless, Wong asserts that "the invention devices a scheme to encapsulate an outgoing call request with all associated attributes preferably using MIME (Multipurpose Internet Extension) principle from Internet Engineering Task Force (IETF)" (see col. 2, lines 14-22).

Examiner considers that the "all associated attributes" of a call includes original called user identifier. In the same recited section, Wong also asserts that the call setup request is encapsulated in a common format.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Meless zewdu

M, Z

Examiner



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

19 Septmeber 2005.